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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/778,334      | 02/07/2001  | Scott W. Huffer      | 9325-36             | 1473             |

23973 7590 12/29/2003  
DRINKER BIDDLE & REATH  
ONE LOGAN SQUARE  
18TH AND CHERRY STREETS  
PHILADELPHIA, PA 19103-6996

EXAMINER

NOLAN, SANDRA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

DATE MAILED: 12/29/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,334

Applicant(s)

HUFFER ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2003 and 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14 + 16. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-19 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 19 May 2003 (Paper No. 13) has been entered.

### ***Information Disclosure Statement***

3. The information disclosure statements (IDS's) submitted on 19 May 2003 and 20 October 2003 (Paper Nos. 14 and 16) were considered by the examiner. Foreign citations were not supplied and undated citations were not considered.

### ***Amendments to Claims***

4. It is noted that applicants have made several amendments to the claims in the "Amendment following RCE" submitted on 20 October 2003 (Paper No. 15).

### ***Withdrawal of Allowance***

5. The allowance of claims 1-19 is hereby withdrawn, in view of the amendments in Paper No. 15, in order to apply the new ground of rejection below.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang (US 5,616,400) in view of Kurth (US 5,548,005), Dust et al (US 4,889,884) and JP 03119531 (based upon its English abstract).

Zhang, Kurth and Dust were discussed in section 11 of the office action mailed on 16 July 2002 (Paper No. 5).

None of them teaches slip agents in electron beam cured coatings.

JP 033119531 abstract teaches the use of slipping agents in electron beam cured coatings (second sentence of the abstract) to improve the abrasion resistance of articles bearing the coatings (title; use/advantage section).

The '531 abstract's "slipping agents" are deemed to be slip agents.

Since the '531 abstract's agents are present in the coatings when they are cured with electron beams, they are deemed to be "reacted in" the resultant coating layer.

The four references are analogous because they all deal with coated surfaces and/or packaging containing same.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the slipping agents of the '531 abstract in coatings on the outer surface of the films suggested by the combination of Zhang, Kurth and Dust, as discussed in section 11 of Paper No. 5.

The motivation to employ the slipping agent-containing coatings of the '531 abstract in the films suggested by the combination of Zhang, Kurth and Dust is found in the title and the use/advantage section of the '531 abstract, where the abrasion resistance of surfaces coated with its coatings is taught.

It is deemed desirable to produce packaging films that have good abrasion resistance so that the films may be handled/transported with minimal damage.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang (US 5,616,400) in view of Kurth (US 5,548,005), Dust et al (US 4,889,884) and Edlein et al (US 6,528,127).

Zhang, Kurth and Dust were discussed in section 11 of the office action mailed on 16 July 2002 (Paper No. 5).

None of them teaches slip agents in electron beam cured coatings.

Edlein teaches e-beam radiation cured (col. 11, lines 54-55) coatings in protective layers for printed packaging material (abstract). The layer may contain slip

agents (col. 7, lines 41-45). The radiation cured oligomers used in the protective coatings contain "(meth)acrylated epoxides" (col. 10, line 56 through col. 11, line 10; especially col. 11, lines 7-8). At col. 11, lines 40-43, it teaches that the coatings provide scratch resistance during handling.

Edlein's "(meth)acrylated epoxides" are deemed to be suggestive of applicants' epoxy acrylates.

Since slip agents are present in the Edlein coatings when they are cured, they are deemed to "reacted in" the coatings.

The four references are analogous because they all deal with coated surfaces and/or packaging containing same.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the e-beam cured, slip agent containing coatings of Edlein as a protective coatings for the films suggested by the combination of Zhang, Kurth and Dust, as discussed in Paper No. 5, in order to give the films scratch resistance during handling.

The motivation to employ the protective coatings of Edlein on the films suggested by the combination of Zhang, Kurth and Dust is found at col. 11, lines 40-43 of Edlein, where the scratch resistance of packaging films bearing its coatings is discussed.

It is deemed desirable to employ scratch resistant coatings on packaging films so that they may be handled with minimal damage.

**Conclusion**

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan  
Patent Examiner  
Technology Center 1700

SMN/smn  
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19 December 2003